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1652
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/863,824	
	Filing Date	05/23/01	
	First Named Inventor	Turner	
	Group Art Unit	1652	
	Examiner Name	D.M. Ramirez	
Total Number of Pages in This Submission	4	Attorney Docket Number	LEX-0181-USA

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Lance K. Ishimoto Reg. No. 41,866 Lexicon Genetics Incorporated
Signature	<i>Lance K. Ishimoto by David W. Habler</i> DAVID W. HABLER REG. NO. 41,071 24231 PATENT TRADEMARK OFFICE
Date	February 11, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): *Turner et al.*

Application No.: 09/863,824

Filed: May 23, 2001

Title: Novel Human Thrombospondin-Like Proteins
and Polynucleotides Encoding the Same



Group Art Unit: 1652

Examiner: D. Ramirez

Attorney Docket No.:

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RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

The Examiner is respectfully requested to accept the following response to the Restriction and Election Requirement mailed January 11, 2002 (presumed to be Paper No. 6), to consider the remarks therein.

Restriction Requirement

The Examiner has determined that the original claims are directed to five separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1-3, said to be drawn in part to the nucleic acids of SEQ ID NO:1 and the nucleic acid encoding peptide of SEQ ID NO:2, classified in class 536, subclass 23.2.
- Group II: Claims 1 and 4, said to be drawn in part to the nucleic acids of SEQ ID NO:4, classified in class 536, subclass 23.2.
- Group III: Claims 1, and 5, said to be drawn in part to the nucleic acids of SEQ ID NO:6, classified in class 536, subclass 23.2

Response to Restriction and Election Requirement

In response to the Restriction Requirement mailed January 11, 2002 (Paper No. 6), Applicants elect with traverse to prosecute the claims of Group I, comprising Claims 1-3,

said to be drawn in part to the nucleic acids of SEQ ID NO:1 and the nucleic acid encoding peptide of SEQ ID NO:2, classified in class 536, subclass 23.2. Applicants further elect, pursuant to 35 U.S.C. § 121, the species of SEQ ID NO: 1 for initial examination on the merits. Elected Claims 1-3 read on the elected species. Applicants understand their species election is being made solely to expedite examination of the application, and that they are entitled to consideration of additional species upon allowance of a generic claim. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

Applicants' traverse is respectfully based on the fact that the nucleic acid sequences described in SEQ ID NOS: 1, 3 and 5 (and the amino acid sequences they encode, SEQ ID NOS: 2, 4 and 6) are all encoded by a common genetic locus. Accordingly, Applicants respectfully submit that Groups I, II and III (Claims 1-5) should have been combined into a single group of highly related sequences that share a common nexus of invention. It is Applicants' belief that the original Markush Claim 1 was proper. MPEP § 803.02 states:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

All of the claims in the present invention read on splice variants of a novel human thrombospondin-like protein. One of skill in the art would therefore agree that they share a common utility and, as splice variants, they share substantial structural features.

Although Applicants believe that no additional fees are due in connection with this response, the Commissioner is authorized to charge any underpayment or credit any overpayment required with this response to Deposit Account No. 50-0892.

Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. This response was based on an assumption regarding the Examiner's intended groupings. If this assumption has been misplaced, please contact the undersigned Applicants' representative. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should the Examiner have any questions or comments a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

02/11/02
Date

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